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09/488,469

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Yoshiharu Konishi

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EXAMINER

VIDA, MELANIE M

ART UNIT

PAPER NUMBER

2626

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8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/488,469

Applicant(s)

KONISHI ET AL.

Examiner

Melanie M Vida

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12 and 14-25 is/are allowed.
- 6) ☒ Claim(s) 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement(s) (IDS) submitted on 1/20/00 has been considered by the examiner and is attached to this office action.

Response to Amendment

2. This action is responsive to an amendment filed on 1/12/04. Claims 1-25 are pending.

Response to Arguments

3. Applicant's have decided not to file a terminal disclaimer, unless the application is allowable. The double patenting rejection is maintained below. Applicant's arguments filed 1/12/04 have been fully considered but they are not persuasive. The Applicants recite that **claim 13**, contain similar limitations so as to distinguish patentably over the art, (page 14 of 15, last paragraph). The Examiner respectfully disagrees. **Claim 1** recites allowable subject matter as discussed below that is not stated in claim 13. Furthermore, **Claim 13** broadly states an image forming method with the steps of storing one of said plurality of different color images as a background image. The Adobe reference, as cited in the first non-final office, teaches that layers associated with each image, such as the zebra, lion, and map, to name a few, can be used to construct composite images by choosing different layers for the background for each of a plurality of images, (see Adobe, pg. 15-18, Section "Layers", steps 1-21, see figures pg. 261-263). **Claim 13** also recites the step, "setting a color of a main image according to said background image selected", (lines 5-6). The Adobe reference teaches a color picker tool,

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wherein a user can select a foreground color out of the complete set of colors in the foreground image, to change the background color, (pg. 214, Section “To change the foreground and background color”; pg. 218, “Using Adobe Photoshop Color Picker”). Finally, **claim 13**, recites, “forming a synthesized image by synthesizing said main image and said background image”, (lines 7-8). The Adobe reference teaches, by way of figures on page 234, a series of blending modes, wherein a mode is user-selected to control how the pixels in the layer blend with the pixels in the underlying layer. Therefore, the rejection of claim 13 in view of Adobe is maintained.

Specification

4. The disclosure is objected to because of the following informalities:

Misspellings occur in the specification as follows:

“mage” is misspelled (pg. 3, pg. 6, pg. 29);

“CG-ROM” is misspelled, (pg. 36);

“15B is” is misspelled, (pg. 60);

Appropriate correction is required.

Drawings

5. The drawings are objected to because CG-ROM (230) in figure 1 is misspelled. In figure 3, S30, the word “AUTMATIC” is misspelled. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to under 37 CFR 1.83(a) because they fail to show in step S82, "Dithering" the main image as described in the specification, (pg. 40).

The drawings are objected to under 37 CFR 1.83(a) because they fail to show in step S84, "Dithering" the background image as described in the specification, (pg. 40).

The drawings are objected to under 37 CFR 1.83(a) because they fail to show in step S85, "Synthesize Images" the background image and the foreground image, as described in the specification, (pg. 40).

Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

Step "S124" in figure 5;

Step "S86" in figure 4;

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

8. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Figures 15A-15D

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illustrate CPB01, CPB02, CPB03, and CPB04. However, the specification describes CPB0-CPB4 on page 60.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. **Claims 1-25** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4-6, 11-18, 22-23, 26-28, 33, 35-40 of copending Application No. 09/487,503, (hereinafter, '503).

Although the conflicting claims are not identical, they are not patentably distinct from each other because in **claim 1**, the image forming method of forming a main image and a background image is not patentably distinct from the method in claim 1 ('503) for synthesizing a main image and a background image comprising the steps of storing, setting, forming a main image, forming an adjusted background image, and forming a synthesized image, and in claim 5 the steps of forming a shape of a main image, by assigning a validity-indicative one of

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predetermined two values to all pixels of said main shape image as said all valid pixels of said main shape image as said all valid pixels of said main image, and assigning an invalidity-indicative one of said predetermined two values to the remaining pixels of said main image.

Claim 2, the image forming method wherein said background image data candidates include image data items each representative of a dot image formed by inputting data of dots as desired, is identical to claim 4, ('503). **Claim 3**, the image forming method for the step of forming main shape image data item by inputting text data, and converting text data is identical to claim 5 ('503). **Claim 4**, the image forming method with predetermined font data is outline font data is identical to claim 6 ('503). **Claim 5**, the image forming method with a plurality of three, primary colors cyan, magenta, and yellow, is not patentably distinct from claim 11 ('503). **Claim 6**, the image forming method where the plurality of basic colors include a basic color corresponding to a mixed color of said three primary colors is identical to claim 12 ('503). **Claim 7** the image forming method wherein said synthesized image is formed as a print image printed on a printing object, which is identically recited in claim 13 ('503). **Claim 8** the image forming method where the printing object is tape, which is identically recited in claim 14, ('503). **Claim 9** the image forming method has a print image is printed by an ink jet printing method, which is identically recited to claim 15, ('503). **Claim 10** the image forming method has a plurality of basic colors include three primary colors, red, green, and blue, is identically recited in claim 16, ('503). **Claim 11** the image forming method comprising a synthesized image to be displayed on a display screen is identically recited in claim 17, ('503). **Claim 12**, the image forming method with the steps of determining whether or not an automatic main gradation value adjustment should be executed, and the step of setting a background image to the main image gradation

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value is not patentably distinct from claim 18 ('503) the step of determining whether or not the adjustment of said background gradation values should be executed, and the step of forming said synthesized image includes forming said synthesized image based on adjusted background image data when it is determined that the adjustment of said background gradation values should be executed. **Claim 13**, the image forming method comprising the steps of storing, selecting, setting, and forming a synthesized image is identical to the method in claim 22 ('503). **Claim 14** the image forming device for forming a main image and a background image comprising storage means, image-setting means, image gradation-value set-setting means, image data-forming means, and synthesized image data-forming means, is the same as the image forming device in claim 23 ('503). **Claim 15** the image forming device is identical to the device in claim 26 ('503). **Claim 16** the image forming device where the main shape data-forming means comprises text data-inputting means, and conversion means, are identical the main shape data-forming means components on claim 27, ('503). **Claim 17** the image-forming device includes predetermined font data; outline font data is identical to claim 28 ('503). **Claim 18** the image forming device where the plurality of basic colors include cyan, magenta, and yellow, is identically recited in claim 33 ('509). **Claim 19** the image forming device where a plurality of basic colors include a basic color corresponding to a mixed color of said three primary colors, is identically recited in claim 34 ('509). **Claim 20** the image forming device wherein the synthesized image is formed as a print image to be printed on a printing object is identically recited in claim 35 ('509). **Claim 21** the image forming device wherein the printing object is tape, is identically recited in claim 36 ('509). **Claim 22**, the image-forming device wherein the print image is printed by an ink jet printing method, is identically recited in claim 37, ('509). **Claim 23** the image-forming device

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where the plurality of basic primary colors are red, green, blue is identically claimed in claim 38, ('509). **Claim 24**, the image forming device, where the synthesized image is formed as a display image to be displayed on a display screen is identically claimed in claim 39, ('509). **Claim 25**, the image forming device, with adjustment determining means and main image gradation value set-setting means executes said automatic main gradation value adjustment to set one corresponding to said background image to said main image is identical to the image forming device in claim 40, ('509).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. **Claim 13** is rejected under 35 U.S.C. 102(b) as being anticipated by Adobe Photoshop 5.0 User Guide, 1998 (hereinafter, Adobe).

Regarding, **claim 13**, Adobe teaches that layers associated with each image, such as the zebra, lion, and map, to name a few, can be used to construct composite images by choosing different layers for the background for each of a plurality of images, which reads on “an image forming method with the steps of storing one of said plurality of different color images as a background image”, (see Adobe, pg. 15-18, Section “Layers”, steps 1-21, see figures pg. 261-263).

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The Adobe reference teaches a color picker tool, wherein a user can select a foreground color out of the complete set of colors in the foreground image, to change the background color, which reads on “setting a color of a main image according to said background image selected”, (pg. 214, Section “To change the foreground and background color”; pg. 218, “Using Adobe Photoshop Color Picker”).

The Adobe reference teaches a series of blending modes, wherein a mode is user-selected to control how the pixels in the layer blend with the pixels in the underlying layer, which reads on “forming a synthesized image by synthesizing said main image and said background image”, (page 234, see the figures).

Allowable Subject Matter

13. **Claims 1-12, 14-25** are allowed. The following is an examiner statement of reasons for allowance. The prior art of record, specifically, Adobe Photoshop 5.0 User Guide, 1998, and Henry R. Kang, “Digital Color Halftoning”, fail to teach or suggest the collective features of the invention, such as the step of forming a main shape image data item, (see Applicants Arguments, page 13 of 15, third paragraph). Claim 14 contains similar limitations as claim 1.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie M Vida whose telephone number is (703) 306-4220.

The examiner can normally be reached on 8:30 am 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Melanie M Vida
Examiner
Art Unit 2626

MMV
mmv

April 2, 2004

KAW Williams
KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER